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MAY 2 2001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

TECH CENTER 1600/2900

In re Application of: Shah

Serial No.: 09/248,524

Group Art Unit: 1615

Filed: February 9, 1999

Examiner: Berman, Alysia

For: Long-Wearing Cosmetic Compositions

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HKO  
5-31-01

**RESPONSE PURSUANT TO 37 CFR 1.113**

The Assistant Commissioner of Patents and Trademarks

Washington, D.C. 20231

Dear Sir:

In the Examiner's Final Office Action of February 12, 2001, the '072 and the '277 references are cited against Claims 1 to 21 under 35 U.S.C. §103(a). The Examiner finds motivation to combine these references based on the desire to obtain an aqueous colored composition in which the pigments are dissolved and that flows through the wick of a nib pen without clogging. In support of this basis, the Examiner notes that column 3, lines 14 to 18 of the '277 reference states that the pigments in its compositions are completely solubilized in water, and therefore, will pass through the wick without clogging. However, reliance on the '277 reference is misplaced because the '072 compositions are oil containing emulsions. Therefore, as it will be further elaborated on below, one of ordinary skill in the art would not be motivated to take the water-soluble organic pigments of the water-based '277 compositions and incorporate them in the emulsions of the '072 reference because the presence of oil will be expected to cause clogging, and thus, defeats the purpose of the '277 reference. Thus, there is no motivation to combine the cited references. In the absence of a suggestion, teaching, or motivation to combine the prior art references cited against the pending claims, a conclusion of obviousness, as a matter of law, cannot stand. *In re Dembiczak*, 50 USPQ2d 1614, 1618 (CAFC 1999)(see *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 297, 227 USPQ 657, 667 (Fed. Cir. 1985)).

As Applicants previously mentioned in their Response of December 5, 2000, and as it is known to one of ordinary skill in the art, waxes, oils and fats, incorporated into compositions causes clogging. Not only does one of ordinary skill understand the difficulties and challenges of attempting to add water-soluble pigments to an oil containing emulsion, but the cited '277 reference supports this as well at column 1, lines 22 to 31, where the '277 reference clearly explains that oil causes clogging.

Therefore, the '277 reference teaches away from combining its water-soluble pigments with the '072 reference, and the Examiner has not responded to this argument. MPEP 707.07(f). Further, the cited references fail to teach or suggest that water-soluble pigments can be used with the polymeric component of the present invention.

The compositions of the present invention utilize a simple acrylic or methacrylic acid derived polymeric system that permits the beneficial use of water-soluble pigments without the drawbacks of fading and running. The present invention is unexpected because water-soluble pigments are known to fade and run when used in a color composition. The ability to achieve this with water soluble pigments is not taught or suggested by the cited references because the '072 reference uses oil soluble pigments in an oil containing system, and the '277 reference fails to teach or suggest the polymeric component of the present invention. Therefore, each of the cited references fails to render the present invention obvious. Moreover, the methods of the present invention in preparing the compositions by a simple combination of the acrylic or methacrylic acid derived polymer with the water soluble organic pigments are not taught or suggested by the cited references.

Because there is no motivation to combine the '072 and the '277 references and because the combination of these cited references fails to teach or suggest the present invention, Applicants submit that the claims of the present application satisfy the requirements of 35 U.S.C. §103(a), and Applicants request that the rejection under 35 U.S.C. §103(a) be withdrawn.

#### CONCLUSION

In view of the arguments presented above in the present submission, the claims are believed to either be in condition for allowance and issuance of a Notice of Allowance is respectfully solicited.

Respectfully submitted,

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*May 14, 2001*

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